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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/881,096	06/24/1997	GREGORY J. SPEICHER	935-008	2718

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708 THIRD AVENUE
NEW YORK, NY 10017

EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

08/881,096

Applicant(s)

SPEICHER, GREGORY J.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-14,41-46,48 and 49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-14,41-46,48 and 49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 1997 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9 June 2003 has been entered.

Response to Arguments

2. Applicant's arguments filed with an amendment on 9 June 2003 (Paper No. 19) have been fully considered but they are moot in view of the new basis of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 9-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At claim 9, lines 8 and 13 are identical, which provides no logical basis for choosing between Internet and telephone routes (lines 10 and 15). This rejection can be overcome by adding "not" at two places in line 13, to read "said system, after determining that said advertiser is not connected to the Internet and not prepared to".

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 USC 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 3-14, 41-46, 48 and 49 are rejected under 35 USC 103(a) as obvious over Hyodo in view of Rondeau and Jonas et al.
7. Hyodo teaches (independent claims 3, 9 and 41) a method and apparatus for providing a computer-based advertising system, the method comprising: an advertiser placing an advertisement on said system (col. 4 lines 12-13); storing the advertisement in a database on the system and publishing the advertisement via the Internet (col. 3 lines 13-14 and col. 4 lines 12-13); wherein said system receives a first connection from a user via the Internet in response to the advertisement (col. 4 lines 12-14).
8. Hyodo does not teach that the first connection is a voice connection. Also, Hyodo does not teach that the system initiates a second voice connection with the advertiser via telephone, and wherein the system couples the first and second connections, enabling a voice connection between the user and advertiser. Rondeau teaches (col. 1 lines 62-65) initiating communication with an advertising computer by telephone, which reads on a first connection that is a voice connection, and Rondeau teaches (col. 3 lines 3-10) that the system initiates a second voice connection with the advertiser via telephone, enabling a voice connection between the user and advertiser. Because the Hyodo service would be enhanced by facilitating users to talk to advertisers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Rondeau to those of Hyodo.
9. Neither Hyodo nor Rondeau explicitly teaches that the system couples said first voice connection with said second voice connection. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that Rondeau does teach a first connection that is a voice connection (col. 1 lines 62-65), and Rondeau does teach enabling a voice connection between the user and advertiser (col. 3 lines 1-24), so the two voice connections must be coupled.
10. Neither Hyodo nor Rondeau teaches determining that said advertiser is, or is not connected to the Internet, and accordingly routing the voice call via the Internet or telephone systems. Jonas et al. teaches call forwarding and routing calls via the Internet or the telephone (para. [0012] and claim 1), which reads on determining that a caller is or is not connected to the Internet, and accordingly routing the voice call via the Internet or telephone systems.

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Because it would be pointless to provide multiple communication routes without call forwarding from a busy/unanswered route to an alternative, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Jonas et al. to those of Rondeau and Hyodo.

11. The references do not teach (independent claim 41 and dependent claim 48) that the system connects the user with advertiser by executing a sequence of instructions in an advertiser specified order, an iterative number of times, over a predetermined interval until the connection is made. Because it was common, at the time of the invention, for advertisers to have multiple contact numbers (Hyodo lists two at col. 3 lines 29-30), and because it would enhance the service to provide access to more than one of these numbers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to provide access in an advertiser specified order, an iterative number of times, over a predetermined interval. All of these options were common with electronic communications at the time of the invention, and users would have expected to be provided with this flexibility.
12. The references do not teach (claim 49) the time of a call. As noted in the last paragraph, that sort of flexibility was common and therefore would be expected by users at the time of the instant invention.
13. The references do not teach (claims 4 and 10) maintaining anonymity of the advertiser. This is a well-known property of personals ads.
14. Hyodo also teaches (claims 5, 6, 8, 11, 12, 14, 42 and 46): text advertising, the toll free number, col. 2 lines 34-35, which also reads on an electronic address; telephoning the toll-free number (col. 2 lines 39-40), which reads on audio advertising; and charging the advertiser (col. 4 lines 50-55).
15. Hyodo does not teach (claims 7 and 13) video advertising. Because the reference teaches the WWW, over which video distribution was common at the time of the instant invention, and because video enhances advertising, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add video advertising to the teaching of Hyodo.
16. Hyodo does not teach (claims 43-45) that the contact number is an Internet/LAN/e-mail address. However, the reference does teach the opposite communication, from advertiser

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to user, via the Internet/LAN/e-mail (col. 1 line 28), and because the service would be enhanced by providing as many means for contacting the advertiser as possible, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Internet/LAN/e-mail contact numbers to the teaching of Hyodo.

Conclusion

17. **COPY of REFERENCES** - Applicant is entitled to receive a copy of every reference cited by the examiner (except at allowance; MPEP 707.05(a)). Applicant should contact the examiner if a completed form PTO-892 is enclosed, but the cited references are not.
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 703-746-5536.
19. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.
20. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



Donald L. Champagne
Examiner
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22 November 2003